

REMARKS

Applicants have amended Claims 4-11. Applicants respectfully submit no new matter has been added by the present amendment. Support for the amendment can be found generally throughout the text, specifically at page 2, lines 11-17. Applicants submit that it is for the inventor to decide what bounds of protection he will seek and he has the right to retreat to otherwise patentable subject matter because only part of what was originally claimed is patentable. In re Johnson, 194 USPQ 187, 195-96 (CCPA 1977).

Claims Rejections under 35 U.S.C. § 102(b)/103(a)

Claims 4-11 are rejected under 35 U.S.C. § 102(b) as anticipated by or in the alternative, under 35 U.S.C. § 103(a) as obvious over Trivette, Jr. et al. Applicants respectfully traverse this ground of rejection.

Applicants submit that in order to anticipate a claim the prior art reference must teach each and every element of the claimed invention, either expressly or inherently. Also, Applicants respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claims limitations. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure." See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

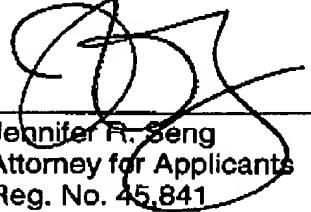
The present invention is directed to a process for preparing a masticated rubber comprising masticating a rubber in the presence of a dialkyl polysulfide as claimed, wherein the process is carried out in the absence of vulcanizing agents. In the alternative Trivette Jr. et al. discloses a process for inhibiting the pre-vulcanization (scorching) of rubber comprising incorporating an organic sulfide in the presence of a sulfur-vulcanizing agent. See Column 2, lines 11-15. Applicants

submit the present invention does not teach each and every element of the claimed invention or suggest the elements of the claimed invention as the claimed process is carried out in the absence of a vulcanizing agent.

Further, as previously argued, in a process comprising mastication no vulcanizing occurs. And as noted at page 2 of the present invention, mastication must happen prior to and in a separate processing step than vulcanization. Accordingly, following mastication the rubber is still "shapeable." In contrast thereto, a process that requires the presence of vulcanizing agents and vulcanization is carried out in a machine, for example a press, which provides the final shaped article (i.e., no longer a shapable compound) i.e., the process disclosed by Trivette, Jr. et al. which requires vulcanization. Accordingly, Applicants submit Trivette, Jr. et al. fails to teach each element of the claimed invention or suggest the claimed process, therefore Applicants request withdrawal of this ground of rejection.

Respectfully submitted,

By _____


Jennifer R. Seng
Attorney for Applicants
Reg. No. 45,841

LANXESS Corporation
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, Pennsylvania 15275-1112
(412) 809-2233
FACSIMILE PHONE NUMBER:
(412) 809-1054

\sr\S:\Law Shared\SHARED\JRS\PATENTS\5861\response 10-25-05.doc